

REMARKS/ARGUMENTS

The Office Action dated April 26, 2005, has been received and carefully considered, and in view of the foregoing amendments and following remarks, reconsideration and allowance of all of the claims pending in the application are respectfully requested.

US Patent Application 2005/0020223 to Ellis

Applicants' patent application was filed January 25, 2002. The primary reference Ellis has a filing date of June 15, 2004 and is a continuation in part (CIP) of Application Serial No. 10/645,928 which has a filing date of August 20, 2003 and is a continuation of PCT/US02/05039 filed on February 20, 2002, which is *after* the filing date of Applicants' patent application.

Therefore, it appears that the Office Action is relying upon the provisional application 60/270,463, filed February 20, 2001. This is only valid prior art if the subject matter is fully supported under the first paragraph of 35 U.S.C. § 112 by the provisional application. MPEP 706.02. In addition, as Ellis 2005/0020223 claims CIP benefit of US Application No. 10/645,928, there must be a showing of support in the prior parent application for the relied upon subject matter. The Office Action has failed to show that the subject matter is fully supported. Absent such a showing, the primary reference is not valid prior art and the filing date of June 15, 2004 is the effective filing date of the Ellis application.

However, in an effort to expedite prosecution and advance the issues, Applicants have amended the claims and earnestly request allowance of all the pending claims.

Rejections Under 35 U.S.C. § 103

Claims 1, 2, 4-8 and 10-13 are currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application 2005/0020223 to Ellis ("Ellis") in view of U.S. Patent Application 2001/0048749 to Ohmura ("Ohmura"). Claim 3 is currently rejected

under 35 U.S.C. § 103(a) as being allegedly unpatentable over Ellis in view of Ohmura and further in view of U.S. Patent No. 4,831,610 to Hoda *et al* (“Hoda”). Claim 9 is currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Ellis in view of Ohmura and further in view of U.S. Patent No. 4,126,827 to Negrini (“Negrini”).

Ellis purports to be directed to a radio system for providing the capture and playback of one or more radio stations. More specifically, the user of Ellis’ radio system may tune to a station, scan through stations rewind to hear what was missed, fast forward through undesired content and perform other function associated with content from various radio stations. Ellis is directed to providing content from multiple radio stations, and fails to show a single source of MP3 content. At least this claimed limitation is completely missing from the disclosure of Ellis.

The Office Action admits that Ellis fails to disclose various features of the now amended independent claim 1. More specifically, the Office Actions admits that Ellis fails to show at least the limitations directed to “*wherein the voice activated input device further comprises a microphone attached to one or more of a visor and a steering wheel of the automobile;*” “*wherein the voice activated input device operates as a voice recognition device wherein one or more specific users are authorized to control the system via the input unit;*” “*a bar code scanner for selecting one or more digital audio selections;*” and “*a dashboard unit comprising a liquid crystal display for displaying media data related to the digital audio content in response to the digital audio selection;*” and “*wherein the digital audio content further comprises video data for display on the liquid crystal display of the dashboard unit.*” In addition, claim 1 has been amended to clarify that the microprocessor decodes and delivers digital audio content *from a single source of MP3 content.*

For these major deficiencies, the Office Action relies upon assertions that certain features are well known and alleged teachings from multiple references, namely Ohmura, Hoda and Negrini. In addressing the missing elements, the Office Action propose various combinations without any proper basis for motivation. The alleged motivation relied upon by the Office Action fails to consider how the system of Ellis could be reasonably modified based on the alleged teachings. The relied upon teachings fail to disclose the admitted deficiencies of Ellis. Further, there would be no motivation available to one of ordinary skill in the art at the time of the invention to combine the system of Ellis, Ohmura, Hoda and Negrini, in various combinations, absent improper hindsight.

For the limitation directed to a bar code scanner, the Office Action relies upon Hoda. The Office Action has failed to explain why one of ordinary skill in the art would incorporate a bar code scanner for selecting one or more digital audio selections in the radio system of Ellis for selecting radio stations. As recognized by the Office Action, Ellis fails to disclose a liquid crystal display. The Office Action has failed to explain why one of ordinary skill in the art would incorporate the claimed liquid crystal display in the radio system of Ellis where Ellis is directed to merely displaying the radio station. The Office Action has further failed to explain why one of ordinary skill in the art would incorporate video data in the display of radio stations in Ellis. In addition, there is nothing in Ellis that indicates that voice recognition is a desirable feature and the Office Action has failed to explain why one of ordinary skill in the art would incorporate the voice recognition feature, absent improper hindsight.

The Office Action has failed to set forth a *prima facie* case of obviousness for the claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been

motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's sole justification for modifying Ellis has absolutely nothing to do with the deficiencies of Ellis. As admitted by the Office Action, Ellis fails to show at least "*wherein the voice activated input device further comprises a microphone attached to one or more of a visor and a steering wheel of the automobile;*" "*wherein the voice activated input device operates as a voice recognition device wherein one or more specific users are authorized to control the system via the input unit;*" "*a bar code scanner for selecting one or more digital audio selections;*" and "*a dashboard unit comprising a liquid crystal display for displaying media data related to the digital audio content in response to the digital audio selection;*" and "*wherein the digital audio content further comprises video data for display on the liquid crystal display of the dashboard unit.*" In addition, Ellis further fails to show that a microprocessor decodes and delivers digital audio content *from a single source of MP3 content*. The Office Action's justification for modifying Ellis has nothing to do with the deficiencies of Ellis and what the other references purport to teach or disclose. Further, the statements of motivation fail to consider how Ellis could be modified by the teachings of the alleged admitted prior art. To properly modify Ellis to correct for these major deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with Ellis. Any such motivation is completely lacking. This is a clear example of improper hindsight.

The mere fact that Ellis can be modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In *In re Hedges*, 783, F.2d 1038, 1041, 228 U.S.P.Q. 685, 687, (Fed. Cir. 1986), the U.S. Court of Appeals for the Federal Circuit stated that "the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill." The court also stated that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art" (quoting *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA, 1965)).

Therefore, the proposed combinations involving Ellis and the other applied fail to show, teach or make obvious the invention as claimed by Applicants. The Office Action has failed to provide proper motivation for modifying Ellis. Even if the Ellis reference could be combined with the alleged admitted prior art as suggested by the Office Action, the resulting combination would fail to disclose the combination of claimed limitations. Therefore, the Office Action has failed to meet its burden. The rejection of pending claims under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed accordingly.

CONCLUSION

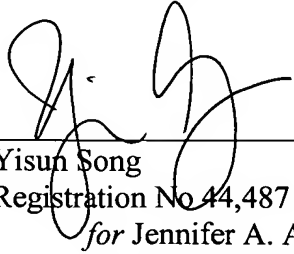
In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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